Remarks

Arrangement of the Specification

We note the Examiner's requested changes to the Specification and acknowledge that Section Headings need to be added. However, Applicant's attorney does not have an electronic file for the Specification. We have requested an electronic file from the Applicant and will provide a revised copy and a marked-up copy of the Specification with Section Headings as soon as the electronic file is received. Applicant wishes to thank the Examiner in advance for his patience in waiting for the revised Specification.

Drawings

Enclosed is a Letter to the Draftsperson of the Patent Office requesting the Examiner's approval of the legends shown in red in the Figure.

Claim Rejections Under 35 USC 112(2)

We respectfully believe that new claims 18-34 address all "112" objections set forth in the Office Action regarding proper antecedent bases.

Claim Rejections Under 35 USC 102

The Patent to Nevel et al. (Nevel)

Claims 1, 2, 5-9, and 11-17 are rejected as being anticipated by Nevel.

Valid rejection under 35 USC 102 requires that each feature of a rejected claim be disclosed in a single reference. "For anticipation under 35 USC 102, the reference must teach every aspect of the claimed invention either explicitly or impliedly. Any feature not directly taught must be inherently present." MPEP 706.02(a)

Nevel does not disclose each of the features recited in the rejected claims.

Head claim 18 of the present application recites:

An apparatus for development of fabrics, comprising:

a display device,

a structure input device,

at least one measuring device for measuring individual yarn diameters, and

a control and evaluation device,

wherein the structure input device enables inputting and changing freely definable structures, and

wherein an actual fabric is computed and represented on the basis of the individual yarn diameters and the freely definable structures,

whereby a defined structure of the fabric can be changed to adapt and optimize the actual fabric to the measured individual yarn diameters.

Independent claim 34 of the present application recites:

A method for development of fabrics on the basis of measured yarn data using an apparatus having a display device,

said method comprising the steps of:

measuring individual yarn diameters,

defining a freely definable structure,

computing and representing an actual fabric on the basis of the measured yarn diameters and the freely definable structure,

changing the actual structure of the fabric so that the actual fabric is adapted and optimized to the measured individual yarn diameters.

Nevel discloses a method for dynamically clearing yarns. In Nevel, the defects in the yarn, e.g., hairs, slugs, or other thick spots) are measured and the positions of the defects on the running yarn are located. Nevel describes a method for clearing (i.e. removing) the defects from the yarn downstream of the running yarn. In Nevel, the defective portions are cut out from the yarn by automatically commanding the yarn clearer.

Nevel does not disclose an apparatus and a method for the development of actual fabric having the features disclosed in claims 18 and 34.

Consequently, the present application should be allowable in view of Nevel.

Claim Rejections Under 35 USC 103

Claims 3, 4 and 10 are rejected under 35 USC 103(a) as being unpatentable over Nevel in view of Massen.

As explained above in the discussion of Nevel under the 102 argument, Nevel does not anticipate the features of independent claims 18 and 34 . Thus, the claims of the present application depending from claims 18 and 34 should be allowable.

Moreover, valid rejection under 35 USC 103(a) requires evidence of a suggestion or motivation for one skilled in the art to combine prior art references to produce the claimed invention. US Court of Appeals for the Federal Circuit (*Ecolochem inc. v Southern California Co., Fed. Cir.,* No. 99/1043, 9/7/00).

The best defense against hindsight-based obviousness analysis is the rigorous application of the requirement for showing a teaching or motivation to combine the prior art references, according to the court.

Nevel and Massen do not motivate or suggest to one skilled in the art to combine these references to produce Applicant's claimed invention.

Recently, in In Re Sang-Su Lee (00-1158) the Court of Appeals for the Federal Circuit rendered a decision confirming the above principles. The court analyzed 35 USC 103 requirements starting from the Administrative Procedure Act and held (citations omitted):

> "Tribunals of the PTO are governed by the Administrative Procedure Act, and their rulings receive the same judicial deference as do tribunals of other administrative agencies.
>
> "The Administrative Procedure Act, which governs the proceedings of administrative agencies and related judicial review, establishes a scheme of "reasoned decision making." Not only must an agency's decreed result be within the scope of its lawful authority, but the process by which it reaches that result must be logical and rational.
>
> "As applied to the determination of patentability vel non when the issue is obviousness, it is fundamental that rejections under 35 USC §103 must be based on evidence comprehended by the language of that section. (Emphasis added). When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness. (Emphasis added)
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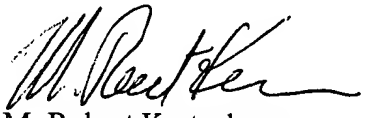
> "The factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. This precedent has been

reinforced in myriad decisions, and cannot be dispensed with. Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. There must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the Applicant. Teachings of references can be combined only if there is some suggestion or incentive to do so."

As stated above, Nevel and Massen do not motivate or suggest to a person skilled in the art to combine these references to duplicate the claims of the present invention. Wherefore, further consideration and allowance of the claims in this application is respectfully requested.

A three-month extension of time in which to response to the outstanding Office Action is hereby requested. PTO-2038 authorizing credit card payment for the amount of $460 is enclosed for the prescribed Large Entity two-month extension fee. Any other fee due by virtue of this filing or this application should be charged to Deposit Account 11-0665. Any refunds in connection with this filing should be credited to Deposit Account 11-0665. A duplicate of this page is enclosed for this purpose.

Respectfully submitted,



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I hereby certify this correspondence is being deposited with the U.S Postal Service as a first class mail in an envelope with adequate postage addresses to Box Response, Commissioner for Patents, Washington, D.C. 20231 on August 29, 2002.

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